

JUL 31 2006



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## FACSIMILE TRANSMITTAL SHEET

**FIRM/COMPANY:** USPTO

**FACSIMILE NUMBER:** 571-273-8300

**CONFIRMATION  
TELEPHONE:**

**FROM:** Paul A. Schwarz, Esq.

**DIRECT DIAL:** 609.631.2446

**DATE:** July 31, 2006

**FILE :** ATTORNEY DOCKET NO.: IPE-1/N1182-1  
APPLICATION SERIAL NO. 10/712,825  
FILED: 11/13/2003  
ART UNIT: 3765

**TOTAL # OF PAGES:** FIVE (5)  
(INCLUDING COVERSHEET)

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DM2673791.1

JUL 31 2006

<b>AMENDMENT TRANSMITTAL LETTER (Large Entity)</b>					Docket No. <b>IPE-1/N1182-1</b>									
Applicant(s): <b>Mark D. Monica</b>														
Application No. <b>10/712,825</b>	Filing Date <b>11/13/2003</b>	Examiner <b>Tajash D. Patel</b>	Customer No. <b>28581</b>	Group Art Unit <b>3765</b>	Confirmation No. <b>8830</b>									
Invention: <b>PROTECTIVE PAD APPARATUS HAVING AIR VENTILATING AND RESTRICTIV RADIANT HEAT TRANSFER/ABSORPTION ASPECTS</b>														
<b>COMMISSIONER FOR PATENTS:</b>														
Transmitted herewith is an amendment in the above-identified application. The fee has been calculated and is transmitted as shown below.														
<b>CLAIMS AS AMENDED</b>														
	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST # PREV. PAID FOR	NUMBER EXTRA CLAIMS PRESENT	RATE	ADDITIONAL FEE									
<b>TOTAL CLAIMS</b>	134 -	155 =	0	x \$50.00	\$0.00									
<b>INDEP. CLAIMS</b>	9 -	9 =	0	x \$200.00	\$0.00									
Multiple Dependent Claims (check if applicable) <input type="checkbox"/>					\$0.00									
<b>TOTAL ADDITIONAL FEE FOR THIS AMENDMENT</b>					<b>\$0.00</b>									
<input checked="" type="checkbox"/> No additional fee is required for amendment. <input type="checkbox"/> Please charge Deposit Account No. _____ in the amount of _____ <input type="checkbox"/> A check in the amount of _____ to cover the filing fee is enclosed. <input checked="" type="checkbox"/> The Director is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account 04-1679 <input checked="" type="checkbox"/> Any additional filing fees required under 37 C.F.R. 1.16. <input checked="" type="checkbox"/> Any patent application processing fees under 37 CFR 1.17. <input type="checkbox"/> Payment by credit card. Form PTO-2038.														
<b>WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</b>														
 Signature			Dated: July 31, 2006											
<b>Paul A. Schwarz</b> <b>PTO Registration No. 37,577</b>  <b>Duane Morris LLP</b> <b>P.O. Box 5203</b> <b>Princeton, New Jersey 08543-5203</b> <b>Telephone: 609-631-2446</b> <b>Facsimile: 609-631-2401</b>			<table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td colspan="2">I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____</td> </tr> <tr> <td colspan="2" style="text-align: center;">(Date)</td> </tr> <tr> <td colspan="2" style="text-align: center;">Signature of Person Mailing Correspondence</td> </tr> <tr> <td colspan="2" style="text-align: center;">Typed or Printed Name of Person Mailing Correspondence</td> </tr> </table>				I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____		(Date)		Signature of Person Mailing Correspondence		Typed or Printed Name of Person Mailing Correspondence	
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cc:														

P11/LARGE/REV10

Serial No. 10/712,825  
Atty. Docket No.: IPE-1/N1182-1

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Patent Application of:  
Mark D. Monica

Group Art Unit: 3765

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Serial No.: 10/712,825

Examiner: Patel, Tajash D.

JUL 31 2006

Filing Date: November 13, 2003

Attorney Docket No.: IPE-1

For: Protective Pad Apparatus Having Air  
Ventilating and Restrictive Radiant Heat  
Transfer/Absorption Aspects

Date: July 31, 2006

## CERTIFICATE OF FACSIMILE TRANSMISSION, 37 C.F.R. §1.8(a)

I certify that this correspondence and the enclosures mentioned therein are  
being transmitted via facsimile to telephone number (571) 273-8306,  
addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria,  
VA 22313-1450.

*Melody Dye*  
Melody Dye

July 31, 2006  
Date

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Va. 22313-1450

## ELECTION

Dear Sir:

This paper is responsive to the Office Action dated June 30, 2006.

Claims 1, 3-5, 10, 12-20, 22, 23, 28-32, 34-47, 49, 50, 52, 53, 55-97, 100-102, 104-115, 117-119, 122-124, 129-135 and 160-173 are pending and stand subject to a Restriction or Election Requirement. In support of the requirement, the Examiner states that the application contains two (2) distinct inventions:

invention I: Claims 1, 3-5, 10, 12-20, 22, 23, 28-32, 34-47, 49, 50, 52, 53, 55-97, 100-102, 104-115, 117-119, 122-124, 129-135, drawn to a protective laminated, breathable pad, classified in class 2, subclass 455, and

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Attorney Docket No. IPE-1/N1182-1

invention II: Claims 160-173, drawn to a shoulder pad, classified in class 2, subclass 459.

In response, invention I, claims 1, 3-5, 10, 12-20, 22, 23, 28-32, 34-47, 49, 50, 52, 53, 55-97, 100-102, 104-115, 117-119, 122-124, 129-135, is elected for prosecution on the merits. This election is made with traverse.

The Examiner alleges that inventions I and II are distinct, each from the other because they are unrelated to one another since invention I pertains to a laminated pad, while invention II pertains to a shoulder pad.

Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different function or different effects. The Examiner has not shown or provided any evidence that inventions I and II are not disclosed as capable of use together and they have different modes of operation. In addition, the Examiner has not shown or provided any evidence that inventions I and II function differently or provide different effects. Accordingly, the Examiner has not shown that the inventions are unrelated.

The Applicant respectfully submits that inventions I and II are related. For example, claim 1 (invention I) and claim 160 (invention II) are compared below:

- 1.) A protective pad apparatus comprising:
  - a shell assembly; and
  - a cushioning pad fastened to the shell assembly, the cushioning pad comprising a laminate including at least one impact absorbing layer comprising a foam material which allows air to flow therethrough, an outer fabric layer that reflects heat and an inner fabric layer that allows air to flow therethrough, wherein the outer fabric layer faces toward the shell assembly and comprises a light color.
- 160.) A protective shoulder pad apparatus comprising:
  - a light-colored shell assembly which reflects heat; and
  - a cushioning pad fastened to the shell assembly, the cushioning pad comprising:
    - a laminate including at least one foam layer which allows air to flow therethrough;
    - a light-colored outer fabric layer which reflects heat and faces toward the shell assembly; and

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an inner fabric layer which allows air to flow  
therethrough, wherein the outer fabric layer faces toward  
the shell assembly and comprises a light color.

As can be seen, claims 1 and 160 are both directed to a protective pad apparatus, where claim 160 is limited to a protective shoulder pad apparatus, and claim 1 is not. Moreover, claims 1 and 160 both require a shell assembly and a cushioning pad fastened to the shell assembly. Thus, although inventions I and II differ scope, they are related to each other. Consequently, the restriction requirement is improper.

In view of the foregoing, withdrawal of the restriction requirement is respectfully requested.

The Commissioner is hereby authorized to charge payment of any filing fees required under 37 CFR 1.16 and any patent application processing fees under 37 CFR 1.17, which are associated with this paper, or credit any overpayment to Deposit Account No. 04-1679.

Respectfully submitted,



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Registration No. 37,577

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